

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE DIRECTOR

In re Application Yasuhiro Ishii, et al)
Serial No. 09/655,847)
Filed: September 6, 2000)
_____)

Decision on Request
under 37 C.F.R. § 1.304(a)(3)(ii)

MEMORANDUM AND ORDER

On November 7, 2008, patent applicants Yasuhiro Ishii et al (Ishii) filed a request seeking an extension of time under 37 C.F.R. § 1.304(a)(3)(ii)¹ to file a Notice of Appeal in application serial number 09/655,847. Ishii later filed a supplemental petition on November 19, 2008, in which he further presented facts in support of his argument for a time extension under Rule 304(a)(3)(ii).

Ishii's petition is granted.

On July 16, 2008, the Board of Patent Appeals and Interferences (Board) issued a decision affirming-in-part the final rejection of Ishii's pending claims. The cover sheet communicating the Board decision to Ishii had a "mail date" of July 17, 2008 – one day later than the "issue date" of the Board decision. On September 17, 2008, Ishii filed a Notice of Appeal to the Court of Appeals for the Federal Circuit for review of the Board decision.

However, the controlling date for an applicant to file either a civil action in district court, or an appeal with the Federal Circuit, is the issue date of the Board decision. *See* 35 U.S.C. § 141; 37 C.F.R. § 1.304(a). Here, that date is July 16, 2008. Thus, Ishii had until September 16, 2008, to file his Federal Circuit appeal – making his September 17, 2008 Notice of Appeal one

¹ While Ishii's petition was denominated under 37 C.F.R. § 1.182, the Director treats the petition as brought under 37 C.F.R. § 1.304(a)(3)(ii), which provides for extensions of time to file an appeal to the Federal Circuit, or civil action in district court.

day late. Ishii explains that he mistakenly calculated the appeal notice due date from the “mailing date” because it is that date that typically controls deadlines before the USPTO. He similarly maintains that it is unusual that the “mailing” and “issue” dates on the Board decision be different. Toward that end, Ishii correctly points out that his September 17, 2008 Notice of Appeal was timely based upon the “mailing date.”

The Director may extend the time for civil action or appeal “after the expiration of the period for filing an appeal or commencing a civil action upon a showing that the failure to act was the result of excusable neglect.” 37 C.F.R. § 1.304(a)(3)(ii). The facts above are sufficient to grant the requested time extension. Of particular relevance to granting the petition is the fact that Ishii’s initial notice of appeal would have been timely but-for the difference between the decision “mailing date” and the “issue date,” and the relative rarity of such a difference.

One additional point merits discussion. An applicant must petition the USPTO for a time extension under 37 C.F.R. § 1.304(a)(3) in order to file a notice of appeal or complaint after the two-month filing deadline. *See Barbacid v. Brown*, 223 Fed. Appx. 972 (Fed. Cir. Mar. 19, 2007) (nonprecedential). However, the USPTO loses jurisdiction over an application to perform anything but “purely ministerial” functions once the applicant actually files a notice of appeal with the Federal Circuit, or a complaint in district court. *See generally In re Graves*, 69 F.3d 1147, 1149-50 (Fed. Cir. 1995); *Barbacid*, 223 Fed. Appx. at 974 (dismissing untimely appeal “without prejudice to Barbacid making a written request for an extension of time” under Rule 304(a)(3)). Thus, it is critical that an applicant make an independent assessment of compliance with the two-month filing requirement before electing his rights under Rule 304, or risk delaying a decision on an extension petition. This factor was particularly complicating here since Ishii

filed not one, but two, notices of appeal with the Federal Circuit. The USPTO's ability to decide Ishii's time extension petition was then delayed pending a decision by the Federal Circuit on Ishii's motions to dismiss his appeals; the second appeal (Appeal Number 2009-1134) was dismissed only on January 16, 2009. The Solicitor makes these observations in the hopes that similar complications can be avoided by other applicants in the future.

ORDER

Upon consideration of the petition for an extension of time under 37 C.F.R. § 1.304(a)(3)(ii), it is ORDERED that that petition is granted.

Ishii's time for seeking judicial review under 37 C.F.R. § 1.304(a)(1) is extended from September 16, 2008, to February 20, 2009.



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